

Application No.: 10/719,178

REMARKS

Claims 1-21 are pending in the application. By this amendment, claims 1 and 21 are amended to clarify the role of a clay settling area having an introduction point that first accepts the clay slurry. Claims 1, 6-9, and 21 are amended to replace "injection" with "introduction".

Claims 1-3 and 6-21 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,077,441 to Luke (the Luke Patent). The Office Action argues that the introduction point of the Luke Patent is patentably indistinguishable from the claimed introduction point because it would have been obvious to one skilled in the art to modify the method of the Luke Patent to use the claimed introduction point because such a modification would have been an aid in separating clay fines from the water slurry. The Office Action thus points out that the claimed introduction point is not taught or suggested by the Luke Patent. The Office Action does not point to the prior art as teaching or suggesting the claimed introduction point.

The Application notes that, in contrast to the claimed invention, the Luke Patent requires special steps and/or facilities, e.g., thickening wells. Application, page 2 at ¶10, first line, and page 3, ¶11. Indeed, the Luke Patent teaches that flocculation of clays is to take place in a "well", see for example, column 2 line 46, column 5 line 24, and column 6 lines 43-45. The Luke Patent teaches that the "well" is a specific structure (paragraph bridging columns 4-5); therefore the "well" of the Luke Patent is not a lagoon or clay settlement area. In fact, the use of a "well" is consistently taught throughout the Luke Patent, which includes detailed procedures for removing sediment from the well, for example, at column 6, line 52- column 7, line 12.

In contrast to the Luke Patent, what is claimed is a method for separating suspended clay fines from water in a clay slurry using a clay settling area that first accepts the clay slurry

Application No.: 10/719,178

through an introduction point, with the method comprising introducing the clay slurry into the clay settling area at the introduction point, and introducing a polymeric flocculating agent into the clay slurry at the introduction point. Since the clay settling area first accepts the clay slurry through the introduction point, the present claims do not read on the "well" of the Luke Patent. Using the claimed introduction point advantageously avoids the use of a special "well" as taught by the Luke Patent.

When the claimed invention is viewed as a whole, it clearly improves upon what is taught in the prior art because it avoids the use of special steps and/or facilities. Indeed, it is respectfully pointed out that the Office Action did not make out a *prima facie* case of obviousness because, as admitted in the Office Action, the cited prior art did not supply the claimed introduction point. As stated in MPEP section 2143.03, the prior art reference (or references when combined) must teach or suggest all the claim limitations. This requirement is no mere technicality: If the Examiner fails to establish a prima facie case of obviousness, the obviousness rejection must be withdrawn as a matter of law. *In re Ochiai*, 37 USPQ at 1131, emphasis added ("When the references cited by the examiner fail to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned)."

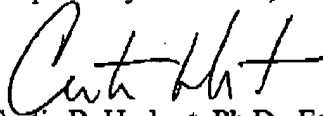
The Office Action further cites U.S. Patent No. 3,932,275 to Mewes et al., but this application does not make up for the deficiencies of the Luke Patent. Accordingly, withdrawal of the rejections of all of the claims is requested.

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Application No.: 10/719,178

Respectfully submitted,



Curtis B. Herbert, Ph.D., Esq.

Registration No. 45,443

Customer No. 24113
Patterson, Thuent, Skaar & Christensen, P.A.
4800 IDS Center
80 South 8th Street
Minneapolis, Minnesota 55402-2100
Telephone: (612) 349-3008